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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,466	09/22/2003	Naoki Fukami	243066USCONT	5513
22850	7590	06/16/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SEAMAN, D MARGARET M	
			ART UNIT	PAPER NUMBER
			1625	
DATE MAILED: 06/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,466

Applicant(s)

FUKAMI ET AL.

Examiner

D. Margaret Seaman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

This application is a CON of 10/138637 (filed 5/6/2002) now ABN which is a CON of 08/981830 (filed 4/20/1998) now ABN which is a 371 of PCT/JP96/01995 (filed 7/18/1996). Claims 1-12 are before the Examiner.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 generically and claims 6-7 specifically, drawn to compounds wherein R¹ is heterocyclic(lower)alkanoyl wherein het=indole, R²=carboxy(lower)alkyl, R³=H, aryl(lower)alkyl or aryl(higher)alkyl, R⁴=carbamoyl(lower)alkyl, R⁵=lower alkyl, cyclo(lower)alkyl(lower)alkyl or aryl(lower)alkyl, classified in class 548, subclass 150+.
 - II. Claims 1-11 generically, drawn to compounds wherein R¹ is heterocyclic(lower)alkanoyl wherein het=quinoline or isoquinoline, R²=carboxy(lower)alkyl, R³=H, aryl(lower)alkyl or aryl(higher)alkyl, R⁴=carbamoyl(lower)alkyl, R⁵=lower alkyl, cyclo(lower)alkyl(lower)alkyl or aryl(lower)alkyl, classified in class 546, subclass 153+.
 - III. Claims 1-11 generically, drawn to compounds wherein R¹ is alkylcarbonyl, phenyl-alkanoyl or maphthylalkanoyl, R²=carboxy(lower)alkyl, R³=H, aryl(lower)alkyl or aryl(higher)alkyl, R⁴=carbamoyl(lower)alkyl, R⁵=lower alkyl, cyclo(lower)alkyl(lower)alkyl or aryl(lower)alkyl, classified in

classes 562-564, subclasses 1+, depending upon an election of a single disclosed species.

- IV. Claims 1-11 generically, drawn to compounds wherein R¹ is heterocyclic(lower)alkyl wherein het is other than indole, quinoline or isoquinoline; R²=carboxy(lower)alkyl, R³=H, aryl(lower)alkyl or aryl(higher)alkyl, R⁴=carbamoyl(lower)alkyl, R⁵=lower alkyl, cyclo(lower)alkyl(lower)alkyl or aryl(lower)alkyl, classified in classes 540-549 548, subclass 1+, depending upon a single elected disclosed species.
- V. Claims 1-11 generically, drawn to compounds wherein R¹ is other than above groups I-IV and R³=heterocyclic(lower)alkyl, classified in classes 540-549, subclass 1+, depending upon a single elected disclosed species.
- VI. Claims 1-11 generically, drawn to compounds other than described in the above groups I-V, classified in classes 540-568, subclass 1+, depending upon a single elected disclosed species.
- VII. Claim 12 generically, drawn to a method of treatment, classified in class 514, subclass 1+ depending upon a single disclosed compound and disease state.

2. The inventions are distinct, each from the other because of the following reasons:

The products of Groups I-VI differ materially in structure and element so much so as to be patentably distinct. In addition, a reference which anticipates one group may not even render obvious the other.

Inventions of Group I and Groups VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product.

3. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for Group I, for example, is not required for Group II, restriction for examination purposes as indicated is proper. Therefore, it would impose an undue burden on the Examiner and the Patent Office's resources to examine the instant application if unrestricted.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 630am-4pm, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. Margaret Seaman
Primary Examiner

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